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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,709	10/18/2001	Andrew C. Gilbert	01-1041	8648
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FISH & NEAVE IP GROUP ROPES & GRAY LLP 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 05/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/982,709

Applicant(s)

GILBERT ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**Status of Claims**

1. Claims 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117 have been examined.

**Response to Amendments/Arguments**

2. Broka et al. teach an interface where a trader can enter both a bid and an offer in a security (figures 18a and b) while, Togher et al. teach a *market maker* interface where a *market maker* makes a bid and an offer of different quantities for the same security, the bid and offer are submitted together, (figures 3 and 5; column 7, lines 20-23 and 35-40; column 11, lines 6-51) and the bid is based on the offer (and vice versa) (column 7, lines 20-23). Applicant is of the opinion that the claims are distinguished from the prior art, as the prior art lacks "generating automatically at least one of a price and a size for an offer to sell the item based on at least one of a price and a size from a bid to buy the item.". Togher et al. clearly state that the intent of a market maker is to have bid price lower than a corresponding offer price, hence the only difference between Applicant's claim 1, for example, and the prior art, is the automatic generation of a sell price in response to a bid. However, it has been held that such a modification of the combined Broka et al. and Togher et al. teachings would have been obvious, as it is not 'invention' to broadly provide an automatic means to replace manual

activity which accomplishes the same result (*In re Venner*, 120 USPQ 192 (CCPA 1958)).

It has been held that claims directed to data stored in memory wherein the data is not functionally related to the computer (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01) and mere recitations of *intended use* of a claimed invention that do not result in additional steps (*Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001)) do not distinguish the claims from the prior art. Therefore, Applicant's claim limitations that are directed to what is stored (i.e. displayed) in computer memory (e.g. claims 2), that merely describe the composition of the data (e.g. claim 4) or that is directed to how data is *intended* to be used or interpreted (e.g. "for specifying..." claim 106, and "for adjusting..." claim 110) do not further limit Applicant's claimed method as neither materially affects the steps of "receiving a bid command...", "generating automatically...", "receiving the bid...", and "receiving the offer...".

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "receiving *the* bid to buy the item" (emphasis added). However, prior to the receiving of the bid, the claim also recites "receiving a *bid command*" and generating an offer to sell based on "at least one of a price and a size for a bid to buy the item...". Therefore, to one of ordinary skill it is not clear which bid is received, the bid command or the bid used to generate the sell offer (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claim 30 is also rejected as it recites similar language.

Claims 2-13, 31-42, and 106-117 are also rejected as each depends from either claim 1 or claim 30.

Claim 4 has been amended to recite "the bid command is received *when* the trader selects *the bid price* for the item" (emphasis added). According to claim 1, Applicant's method is initiated by the receiving of a bid command. However, as claim 4 recites "when" it is unclear to one of ordinary skill whether or not the bid command is ever received (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claims 17, 33, and 47 are also rejected as each recites similar language.

Claims 106-110 and 112-116 are also rejected as each depends from either claim 4 or claim 33.

The term "better" in claims 109 and 115 is a relative term which renders the claim indefinite. The term "better" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broka et al., U.S. Patent No. 5,809,483 in view of Togher et al., U.S. Patent No. 5,375,055.

As per claims 1-5, 10-18, 23-25, 30-34, 39-47, 52-54 and 106-117, Broka et al. teach a market trading system comprising:

- receiving a bid command (e.g. data related to a tradable item display) from a trader to buy an item, generating an offer (or bid) based on the submission of a bid (or offer) command from a trader, generating an offer price or size, and receiving the bid and the offer [by the FIPS system] (e.g. generated offer value) (figure 18a)
- using an interactive display, displaying current bid and offer data and receiving a selection of a piece of the bid and offer data as part of the receiving of the bid command (figures 24, 25, and 30; column 16, lines 6-10; column 17, lines 4-14 and 45-67; column/line 19/9-20/6) and selecting a bid ( or offer) price from the bid and offer data (i.e. viewing market activity- e.g. bid and offer data, and placing a bid, for example, on a desirable issue at a specific price where the price, or offer, was displayed in the market activity) (figure 18a), displaying the current bid and offer data in a window (figure 20a)
- entering the submission of the bid command via keyboard and using a mouse (column 10, lines 58-63)
- presenting a second trading interface (figures 19 and 20a) that contains information relating to a command (figure 18a) and displaying the interface in response to the reception of a bid (or offer) command (figures 19 and 20a; column 14, lines 6-12 and 33-45)

- (claims 106-108 and 112-114) an interface screen comprising at least one field for specifying at least one term for a bid to buy and an offer to sell, populating the at least one field to specify for the bid (offer) to buy (sell) the item with the selected price (figures 18 a and b; column/line 13/53-14/5)
- (claims 109 and 115) populating the at least one field (figures 18 a and b; column 15, lines 18-23) for specifying at least one term for the bid to buy the item with a price a predetermined amount better (figures 21 a and b; column 15, lines 35-48) that the selected bid price (figures 18 a and b)
- (claims 110 and 116) an interface screen with a price up button and down button (figures 21 a and b; column 15, lines 35-48)

Broka et al. do not specifically recite submitting an offer command to sell a second size of the item on behalf of the trader wherein the offer is based on the offer value. Togher et al. teach a market maker interface where a market maker makes a bid and an offer of different quantities for the same security, the bid and offer are submitted together (i.e. simultaneously- claims 111 and 117) (figures 3 and 5; column 7, lines 20-23 and 35-40; column 11, lines 6-51) and the bid is based on the offer (and vice versa) (column 7, lines 20-23). Togher et al. also teach a screen display for displaying current bid and offer data using a market cell, spread sheet, data window, entry window or webpage (figures 3 and 5). Therefore, it would have been obvious to one of ordinary skill to combine the



teachings of Broka et al. and Togher et al. in order to accommodate traders using the Broka et al. system ('483, abstract; figures 2, 4, 18a-b, 30 and 39) who desire to take a more active trading role, such as that of a market maker ('055, column 11, lines 6-11).

Regarding, the generating of "offer values", Broka et al. teach quotes as combination "bids" and "asks" (figure 18a; column 4, lines 52-54). Therefore, the Broka et al. system could be used by "market makers" who are willing to buy and sell a given security at a particular price, "arbitrageurs" seeking to capitalize on price differentials in a security, or market participants executing a trading strategy that involves the simultaneous buying and selling of securities. In each instance, a goal is to turn a profit hence, the second transaction (sell if the initial trade was a buy, or buy if the initial trade was a sale) would be based on the first as both transactions are in the same security. Further, it is well known to those of ordinary skill in the buying and selling of securities to determine a transaction position, and profitability, based on spreads is old and well known.

Regarding the coloring of bid and offer data, Broka et al. teach denoting a piece of data using an asterisk (column 14, lines 55-60) or "highlight" (figure 20a). It has been held that changing the way the system of Broka et al. indicates a dealer's own quote by changing color, for example, would have been an obvious modification to one of ordinary skill (*In re Seid*, 73 USPQ 431, 433 (CCPA 1947)).

Regarding “spread sheets”, the use of spreadsheets software (e.g. cells, columns, rows) to prepare bids and offers is old and well-known, therefore it would have been obvious to one of ordinary skill to download data such as current market data (figure 18a) in order to construct a profitable bid/offer strategy. Similarly, displaying data remotely using the internet and its associated technologies (e.g. webpages, html, etc.) is also well known.

### **Conclusion**

7. Applicants are reminded that patents are written by and for skilled artisans. See e.g. *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”).<sup>1</sup> The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process,

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<sup>1</sup> See also *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001) (“patents are written for persons experienced in the field of the invention”).

and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicants are hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicants can not reasonably understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the reference(s), Applicants should (in their next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicants' response must also state *why* they either do not understand or *why* they have difficulty comprehending the offending reference(s). If after properly receiving (*i.e.* Applicants' response is made of record) both Applicants' request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicants are given actual notice that this paragraph becomes effective when Applicants receive notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicants submit an

Information Disclosure Statement or when Applicants receive an examiner's Notice of References Cited (Form PTO-892)).

Additionally, Applicants are reminded that it is inappropriate for the USPTO to disregard any relevant evidence of record. "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, the USPTO uses the preponderance of the evidence standard.<sup>2</sup> In light of this standard, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) ("All the evidence on the question of obviousness must be considered."); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]"); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002) ("Patentability *vel non* is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . ; patentability is determined by a preponderance of *all* the evidence.

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<sup>2</sup> See MPEP §706 I. "The standard to be applied in *all* cases is the 'preponderance of the evidence' test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable. [Emphasis added.]"

[Emphasis added.]"); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as "Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]"). Third, any factual determination by the USPTO that does *not* consider all relevant evidence of record may not be supported by the required substantial evidence since the particular evidence *not* considered may be probative of a factual issue presented. Fourth, prior art patents are not technical treatises and therefore these patents intentionally omit features that are known in the field of the invention. See *S3 Inc. v. nVIDIA Corp.*, 259 F.3d at 1371, 59 USPQ2d at 1749-50 ("The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader."); and *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)("The specification would be of enormous and unnecessary length if one had to literally reinvent and describe the wheel."). Finally and perhaps most importantly, it is well established that "[a] reference anticipates a claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular*

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*art and be in possession of the invention. [Emphasis in original.]” In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701. Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, because any evidence or record *not* considered by the USPTO may be probative of at least one factual issue presented, because prior art patents need not include subject matter that is known in the field of the invention, and because anticipation is determined by the teachings of a reference in combination with the knowledge of one of ordinary skill in the art, Applicants are hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art.

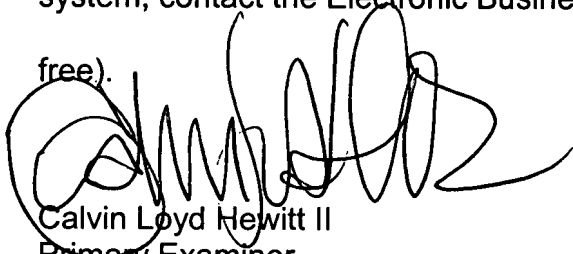
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7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II  
Primary Examiner

May 14, 2007